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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,109	08/08/2000	Gabriel Vogeli		4465

7590

05/06/2003

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EXAMINER

PAK, MICHAEL D

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 05/06/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/634,109

Applicant(s)

VOGELI ET AL.

Examiner

Michael Pak

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-5 and 29, drawn to a purified polypeptide and a composition, classified in Class 530, subclass 350.

II. Claims 6-18, drawn to a purified nucleotide, vector, host cell, and method for producing the polypeptide, classified in Class 435, subclass 69.1.

III. Claims 19-28 and 30, drawn to an antibody, monoclonal antibody, hybridoma, humanized antibody, cell free composition, anti-idiotypic antibody, single chain antibody, and classified in Class 530, subclass 387.9.

IV. Claims 31-32, drawn to a method for modulating activity with antibody, classified in Class 436, subclass 517.

V. Claims 33-39, drawn to a method for administering antibody, classified in Class 424, subclass 130.1.

VI. Claims 40-43, drawn to an assay to identify compounds, classified in Class 435, subclass 7.2.

VII. Claim 44, drawn to a compound, classification could not be determined because no structure was provided.

VIII. Claim 45-48, drawn to a method of administering a compound, classification could not be determined because no structure was provided.

IX. Claims 49, drawn to a method for identifying a modulator, classified in Class 436, subclass 501.

X. Claim 50, drawn to a modulator, classification could not be determined because no structure was provided.

XI. Claim 51-54, drawn to a method of administering a compound, classification could not be determined because no structure was provided.

The inventions are distinct, each from the other because of the following reasons.

The products of inventions I-III, VII, and X are distinct each from the other, because they are drawn to products having different structures and functions.

The methods of inventions IV-VI, VIII, IX and XI, are distinct, each from the other, because they are drawn to processes having materially different process steps, which are practiced for materially different purposes.

The products of invention I, and the processes invention IV, VI, and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products of group I can be used in the alternative processes of anyone of group IV or VI.

The products of Group I is not used or made by the processes of Groups V, VIII, and XI and is distinct one from any other.

The products of Group II is not used or made by the processes of Groups IV-VI, VIII, IX, and XI, and is distinct one from any other.

The products of invention III, and the processes of invention IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products of group III can be used in the alternative processes of anyone of group IV or VI.

The products of Group III is not used or made by the processes of Groups V, VIII, IX and XI, and is distinct one from any other.

The products of invention VII, and the processes of invention VI and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products of group VII can be used in the alternative processes of anyone of group VI or VIII.

The products of Group VII is not used or made by the processes of Groups IV, V, IX and XI, and is distinct one from any other.

The products of invention X, and the processes of invention IX and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can

Art Unit: 1646

be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products of group X can be used in the alternative processes of anyone of group IX or XI.

The products of Group X is not used or made by the processes of Groups IV-VI and VIII, and is distinct one from any other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classifications and the search required for any one of inventions I-XI is not required for any other invention I-XI, thus, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Art Unit: 1646

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Michael D. Pak*

Michael Pak

Primary Patent Examiner

Art Unit 1646

25 September 2002